

REMARKS

The application has been amended and is believed to be in condition for allowance.

Previously, the case was pending with claims 1-11, claim 1 being independent. This amendment amends certain of the previously pending claims and adds new claims 12-20, claims 12 and 18 being independent.

The Official Action stated that certified copies of applicants' priority application had not been received from the International Bureau. Attached to this amendment is a copy of Form PCT/IB/304 showing receipt of the two Japanese priority applications. Accordingly, these applications should be available from the International Bureau.

The Official Action noted incorrect units in claims 4 and 9. Applicants appreciate being notified of this error and have amended the claims appropriately.

As to claim 5, with reference to the drawing figures, it is correct that the second filter layer downstream end is exposed to air and is also the downstream end of the air filter. However, the claim does not specifically recite that the downstream end of the second filter is the downstream of the air filter.

The Official Action suggests a formal amendment to claim 11, which amendment has been made. The same amendment has been made to claim 7.

There are no other formal matters outstanding.

Claim 1 has been amended to clarify the recitations of the first and second filter layers. As amended, it is clear that the first filter layer is formed of a first filter paper material having a predetermined density, the first filter layer being impregnated with oil. Further, it is clear that the second filter layer is provided on a downstream side of the first filter layer so as to be independent from the first filter layer, and that the second filter layer is formed of a second filter paper material having a lower density than the density of the first filter layer. Further, the claim recites the second filter layer being impregnated over its entirety with an oil-repellant agent.

The invention as recited by claim 1 is believed to be both novel and non-obvious over the applied prior art.

Claim 1 is rejected as obvious over Japanese Published Patent Application JP 2000-70635 (reference 1) in view of Japanese Published Patent Application JP 63-14886 (reference 2).

Claims 1-2 and 5 stand rejected as obvious over Japanese Published Patent Application JP 55-114323 (reference 3) in view of reference 2.

As acknowledged by the Official Action, reference 1 does not disclose the filter material of the first filter layer having a higher density than the filter material of the second filter layer. Nor does reference 2 make this disclosure. Reference 2 merely describes formation of a density gradient between a water repellant-impregnating layer and an oil-impregnating layer. There is no disclosure that these two layers have different densities from each other. Indeed, it appears from the drawing figure that a single paper is used and that paper is treated to form a water repellant-impregnating layer and an oil-impregnating layer. In view of the clarified recitations of the pending claims, applicants believe it is clear that this reference fails to teach the missing features.

In view of this, references 1 and 2, taken alone or in any reasonable combination, do not render obvious independent claim 1.

Additionally, applicants do not see that the references teach using two different papers having different densities. Nor do applicants see that the references teach the recited pore size found in the dependent claims. Note that the specification does show that these recited pore sizes give advantageous results.

In view of the above, the obviousness rejection over references 1 and 2 is not believed to be viable. Therefore,

reconsideration and withdrawal of this rejection are respectfully requested.

As to the rejection of claim 1 as being obvious over reference 3 in combination with reference 2, again, note that in reference 2 the resin-impregnating portion 2 and the oil-impregnating portion 3, are formed within a single paper layer. Clearly, there is no teaching of using two paper layers with different densities. Further, reference 2 appears to teach an entirely different approach than reference 3. In view of this, applicants do not believe that there is motivation to combine these two references.

However, even if references 2 and 3 are combined, they do not disclose all the recited features of independent claim 1.

Accordingly, applicants respectfully request reconsideration and withdrawal of this obviousness rejection.

In view of the above, applicants believe that claim 1 is patentable over the prior art. Applicants further believe that the recitations of the dependent claims are patentable in their own right, but note that regardless, these claims are believed allowable at least for depending from an allowable independent claim.

As to new independent claims 12 and 18, these claims are believed to be allowable at least for the reasons stated

above. Further, these claims include additional recitations not seen as being taught or suggested by the applied art.

Accordingly, allowance of claims 11 and 18, as well as the claims depending therefrom, is respectfully requested.

Also note that the features of the dependent claims are not all believed to be taught or suggested by the applied art. In view of this, the dependent claims are believed to be patentable in their own right, as well as being patentable for depending from an allowable independent claim.

Applicants believe that the present application is in condition for allowance and an early indication of the same is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Roland E. Long, Jr., Reg. No. 41,949
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573

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APPENDIX:

The Appendix includes the following item(s):

- copy of Form PCT/IB/304

PATENT COOPERATION TREATY

PCT

NOTIFICATION CONCERNING
SUBMISSION OR TRANSMITTAL
OF PRIORITY DOCUMENT

(PCT Administrative Instructions, Section 411)

From the INTERNATIONAL BUREAU

To:

ISHIKAWA, Yasuo
Park Shiba Building, 4F
17-11, Shiba 2-chome
Minato-ku
Tokyo 105-0014
JAPON

Date of mailing (day/month/year) 01 August 2001 (01.08.01)	
Applicant's or agent's file reference T01-4881	IMPORTANT NOTIFICATION
International application No. PCT/JP01/04226	International filing date (day/month/year) 21 May 2001 (21.05.01)
International publication date (day/month/year) Not yet published	Priority date (day/month/year) 23 May 2000 (23.05.00)
Applicant TOYO ROKI SEIZO KABUSHIKI KAISHA et al	

1. The applicant is hereby notified of the date of receipt (except where the letters "NR" appear in the right-hand column) by the International Bureau of the priority document(s) relating to the earlier application(s) indicated below. Unless otherwise indicated by an asterisk appearing next to a date of receipt, or by the letters "NR", in the right-hand column, the priority document concerned was submitted or transmitted to the International Bureau in compliance with Rule 17.1(a) or (b).
2. This updates and replaces any previously issued notification concerning submission or transmittal of priority documents.
3. An asterisk(*) appearing next to a date of receipt, in the right-hand column, denotes a priority document submitted or transmitted to the International Bureau but not in compliance with Rule 17.1(a) or (b). In such a case, **the attention of the applicant is directed** to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.
4. The letters "NR" appearing in the right-hand column denote a priority document which was not received by the International Bureau or which the applicant did not request the receiving Office to prepare and transmit to the International Bureau, as provided by Rule 17.1(a) or (b), respectively. In such a case, **the attention of the applicant is directed** to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.

<u>Priority date</u>	<u>Priority application No.</u>	<u>Country or regional Office or PCT receiving Office</u>	<u>Date of receipt of priority document</u>
23 May 2000 (23.05.00)	2000-151032	JP	06 July 2001 (06.07.01)
18 May 2001 (18.05.01)	2001-149910	JP	06 July 2001 (06.07.01)

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. (41-22) 740.14.35	Authorized officer Taieb Akremi Telephone No. (41-22) 338.83.38
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